

Response to Office Action dated: March 29, 2004
Reply date: July 28, 2004
Application No.: 09/662,630
Docket No. 0879-0276P

REMARKS

Claims 1-21 are currently pending in this application. Claims 1 and 8 have been amended, and new claims 16-21 are provided. No new matter is involved. Applicants respectfully request reconsideration of the application in light of the amendments and remarks contained herein, and request timely allowance of the pending claims.

In the non-final Office Action, claims 1 and 8 were rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 5,061,061 to Robley et al. (“Robley”); rejected claims 2 and 10 under 35 U.S.C §103(a) as being unpatentable over Robley and further in view of U.S. Patent No. 6,142,913 to Ewert (“Ewert”); rejected claims 3 and 11 under 35 U.S.C §103(a) as being unpatentable over Robley in view of Ewert, and further in view of U.S. Patent No. 3,711,812 to Cherry (“Cherry”); rejected claims 4, 12, 14 and 15 under 35 U.S.C §103(a) as being unpatentable over Robley and further in view of U.S. Patent No. 5,986,718 to Barwacz et al. (“Barwacz”); rejected claim 13 under 35 U.S.C §103(a) as being unpatentable over Robley in view of U.S. Patent No. 6,022,124 to Bourn et al. (“Bourn”); and rejected claims 5 and 9 under 35 U.S.C §103(a) as being unpatentable over Robley. Claims 6 and 7 were withdrawn from consideration by the Examiner based upon a Restriction Requirement.

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Claims Rejections – 35 U.S.C §102(e)

Applicants respectfully traverse the §102(e) rejection of claims 1 and 8.

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). See, In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984).

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

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Regarding claim 1, which recites a combination of features, including providing a treadmill in the floor on which the subject is located, Robley merely discloses use of a treadmill in col. 5, lines 4-18, but does not specify locating the treadmill in the floor on which the subject is located, as recited. This feature is simply not disclosed, either expressly or inherently (which must necessarily occur to be inherently disclosed).

Accordingly, claim 1, as amended, is not anticipated by Robley, and Applicants respectfully request the Examiner to withdraw the §102(e) rejection of claim 1.

Regarding claim 8, which recites a device having a treadmill located in a floor on which the video taking enclosure is located. Robley does not disclose this positively recited feature either expressly or inherently.

Accordingly, Robley does not anticipate claim 8 and Applicants respectfully request the Examiner to withdraw the §102(e) rejection of claim 8.

Applicants also respectfully submit that Ewart, which was applied in the rejection of claims 2 and 10, which recited a treadmill feature, does not disclose placing a treadmill in a floor, as recited, so even if it were proper to combine Ewart with Robley, which it is not because viewing a video display is so substantially different from filming or taking a video of the display and a subject as to teach away from being properly motivated to combine these two references, the combination of Robley and Ewart would not result in, or render obvious, the claimed invention.

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Claim Rejections – 35 U.S.C §103(a): Robley/Ewert

Applicants respectfully traverse the §103(a) rejection of claims 2 and 10 because Robley and Ewert, either singly or in combination, fail to teach or suggest all of the features required by these claims.

This rejection is moot because claims 2 and 10 have been canceled.

Claim Rejections – 35 U.S.C §103(a): Robley/Ewert/Cherry

Applicants respectfully traverse the §103(a) rejection of claims 3 and 11.

It is well settled that a rejection based on 35 USC 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995).

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488

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U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

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Applicants respectfully submit that neither Robley, Ewert nor Cherry, either singly or in any combination, fail to teach or suggest all of the features recited in claims 3 and 11.

Cherry fails to cure the aforementioned deficiencies of Robley and Ewert, at the very least because Cherry fails to teach or suggest locating a treadmill in a floor, as recited. Accordingly, Applicants respectfully request the Examiner to withdraw the §103(a) rejection of claims 3 and 11.

Claim Rejections – 35 U.S.C §103(a): Robley/Barwacz

Applicant respectfully traverse the §103(a) rejection of claims 4, 12, 14 and 15. At the very least, neither Robley nor Barwacz, either separately or in combination, teach or suggest all of the features recited in these claims including, for example, the treadmill in the floor feature. Thus, claims 1, 12, 14 and 15, which positively recite this feature, are not obvious over this combination of references.

Furthermore, regarding claim 14, Robley's two cameras are not built into Robley's screens and there would be no incentive to do so because Robley is a front-projection device in which the camera has to be separated from the screen at least by the subject whose imager is being taken by the cameras.

Additionally, the allegation that it would have been obvious to have included a camera and a screen for each wall of the studio so that a superimposed image could be taken for each wall of the studio is pure speculation and based on no objective evidence

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of record. As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection advanced. An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Also, see In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Further regarding claim 14, the Examiner admits that the walls of the studio disclosed by Robley are not used as the projection screens for projection of background images (Office Action, page 7, lines 4-5). The Examiner then asserts it would have been obvious to project the images directly on the walls of the studio provided that the walls have the same characteristics as the provided projection screens (see Office Action, page 7, lines 5-7). However, this is a proviso that is not taught in the applied references and no objective evidence thereof is of record.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claim 15.

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Claim Rejections – 35 U.S.C §103(a): Robley/Bourn

Applicants respectfully traverse the rejection of claim 13 because Robley or Bourn, either singly or in combination thereof, fails to teach or suggest all of the elements required by claim 13. Claim 13, by virtue of its dependency includes all of the features recited in allowable claim 8. It is noted that Bourn is not applied to supply the positively recited treadmill in the floor feature.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 13.

Claim Rejections - 35 U.S.C §103(a): Robley

Applicants respectfully traverse the §103(a) rejection of claims 5 and 9. Claims 5 and 9 depend from allowable claims 1 and 8 respectively. Robley fails to teach or suggest all of the elements required by claims 5 and 9. Accordingly, Applicants respectfully request the Examiner withdraw the §103(a) rejection of claims 5 and 9.

Furthermore, Applicants traverse the Examiners position in taking Official Notice that “it is well known in the art for cameras to include microphones that record sound and speakers to reproduce sound stored within the camera” (Office Action: page 9, lines 12-14). Applicants thus respectfully request the Examiner either provide a competent prior art reference or a personal affidavit if the rejection is maintained, or withdraw the rejection of claims 5 and 9. See, in this regard, In re Lee, cited above,

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which notes that objective evidence is required to be provided for facts alleged by the examiner in a rejection.

New Claims 16-21

New, independent claim 16 recites a video image producing method, comprising providing a video taking enclosure having a plurality of individual walls which accommodate a subject; providing a plurality of projectors, each of which displays a sequence of images on one of a plurality of wall screens associated with each individual wall of the video taking enclosure; and providing a plurality of video cameras, each of which views a different individual wall screen of the video taking enclosure; and wherein video may be taken by one or more of the cameras by combining the subject and the background image viewed by a given camera.

New independent claim 22 recites a system with features similar to those recited in independent method claim 16.

Support for the features recited in these claims is found throughout Applicants' originally filed disclosure, including the Specification (which includes the claims) and drawings

Applicants respectfully submit that none of the applied references discloses or suggests the combination of features recited in claims 16 and 22.

Dependent claims 17-21 depend from claim 16 and recite additional features.

Accordingly, Applicants respectfully submit claims 1-22 are allowable.

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CONCLUSION

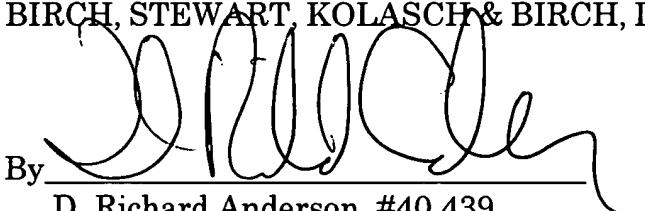
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact D. Richard Anderson (Reg. No. 40,439) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
D. Richard Anderson, #40,439

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Attachment: Check in the amount of \$110.00 for one (1) month extension of time.